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Paper 43

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference No. 105,134

YALE NEMERSON
and WILLIAM H. KONIGSBERG
(08/297,581 and 08/473,262),
Junior Party,

v.

GENENTECH, INC.
(08/437,989 and 08/444,934),
Senior Party.

Entered: 8 March 2005

JUDGMENT - Bd. R. 127(d)
REHEARING OF JUDGMENT

Before TORCZON, MEDLEY, and POTEATE, Administrative Patent Judges.¹

TORCZON, Administrative Patent Judge.

Junior party Nemerson requests (Paper 66) rehearing of the judgment against Nemerson (Paper 65). The judgment followed a decision that Nemerson had failed to make out a facially sufficient case on priority (Paper 64). The judgment and underlying decision have been reheard, but the relief Nemerson requests is DENIED.

Nemerson contends that the sole count, count 1, must be construed to be broader than its literal scope because the Board denied Nemerson's motions to add a

¹ As part of the Board's efforts under the Government Paperwork Elimination Act, signatures on papers originating from the Board are being phased out in favor of a completely electronic record. Consequently, subsequent papers in this case originating at the Board will not have signatures. The parties have agreed to participate in the electronic filing pilot program, which has its own standard for party signatures.

second count and to designate claims in the 08/473,262 [262] application as not corresponding to count 1. According to Nemerson (Paper 66 at 9):

The practical effect of the Board's ruling is that Nemerson's claims to both tissue factor nucleotide sequence and tissue factor protein have been held as corresponding to the Count. Accordingly the "invention" defined for the purposes of this Interference includes both the soluble tissue factor protein and the cDNA and the evidence of conception and reduction to practice of both should be considered as part of a decision on priority.

We note three flaws with Nemerson's contention. First, claim correspondence and count scope are different things. Second, the holding of the decision on the motions in question did not have the effect Nemerson suggests. Finally, Nemerson's contention is contrary to the well-settled law regarding proof of priority with respect to a count.

On the first point, count scope and claim correspondence are necessarily different things. If they were not, there would be no need for the count since claim correspondence alone would suffice to define the scope of the interfering subject matter. Nemerson neither cites authority nor provides reasoning to the contrary.

On the second point, Nemerson cites two of its preliminary motions: motion 2 (Paper 25), which in part sought the undesignation of Nemerson's 262 application claims, and motion 1 (Paper 24), which sought the addition of a second count and designation of the 262 application claims to the new count. Both motions were denied for a failure to make out a facially sufficient case for relief. It would make no sense to create an equitable rule of broad count construction based on failed motions because that would create a perverse incentive to file facially insufficient motions.

The first motion, which sought a separate count, was denied because Nemerson had not shown that the second count would not have been obvious in view of the

subject matter of count 1. It is important to note, however, that the denial was without prejudice for Nemerson to move for a broader count that would expressly encompass the subject matter of both count 1 and Nemerson's proposed count 2. Indeed, the decision dropped a footnote (n.4) pointing to guidance on how to file an effective motion. The decision also expressly cited Eaton v. Evans, 204 F.3d 1094, 53 USPQ2d 1696 (Fed. Cir. 2000), for the consequences of relying on priority proofs outside the explicit scope of the count. Nemerson was provided a well-marked path to the relief it now seeks on rehearing. Nemerson failed to file the motion to broaden the count and must now live with the consequences.

In the second motion, Nemerson argued that the claims should be designated as not corresponding to the count because of a restriction requirement. The decision explained that restrictions are based on a different analysis than claim correspondence and that Nemerson had failed to explain the relevance of the restriction to the question of claim correspondence. Nemerson had also argued that In re Deuel, 51 F.3d 1552, 34 USPQ2d 1210 (Fed. Cir. 1995), supported undesignation. The decision, however, showed that Deuel did not create the per se rule Nemerson urged, but in fact actually distinguished claims to specific nucleic acids from claims to generic nucleic acids. Since neither of the arguments were sufficient on their own merits, the motion was denied with respect to the 262 claims without waiting for an opposition. Cf. Hillman v. Shyamala, 55 USPQ2d 1220, 1221 (BPAI 2000) (motion denied without opposition for facial insufficiency).

Finally, as noted above, cases like Eaton limit the scope of admissible proofs to those that anticipate the count. Indeed, in Eaton, the Board's decision was reversed precisely because it accepted priority proofs to an obvious variant of the count. In short, to grant the relief Nemerson seeks would be to commit reversible error. We decline to do so.

DECIDED that relief from the judgment and decision on priority be DENIED; and

FURTHER DECIDED that a copy of this decision be entered in the administrative records of the Genentech 08/437,989 and 08/444,934 applications and the Nemerson 08/297,581 and 08/473,262 applications.

cc (via electronic mail):

For Nemerson: **Patreo L. Pabst**, PABST PATENT GROUP LLP of Atlanta, Georgia.

For Genentech, Inc.: **R. Danny Huntington** and **Sharon E. Crane**, BURNS, DOANE, SWECKER & MATHIS L.L.P. of Alexandria, Virginia.

Notice: Agreements and understandings regarding the termination of an interference are subject to filing requirements under 35 U.S.C. 135(c).

Notice: In the event of judicial review, note the requirements of Bd. R. 8(b).

Despertt, Sonja

From: Despertt, Sonja on behalf of Interference Trial Section
Sent: Tuesday, March 08, 2005 4:23 PM
To: 'Crane, Sharon (BURNS DOANE)'; 'Huntington, Danny (BURNS DOANE)'; 'Pabst, Patrea (PABST PATENT)'
Subject: Interference No. 105134 (RT) Paper No. 67 - JUDGMENT - Bd.R. 127(d) - Rehearing



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